Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DUANE E. SHULTZ

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Appeal No. 1999-0365
Application 08/601,724

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HEARD: May 22, 2001

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Before JERRY SMITH, RUGGIERO and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, 29, 31, 38-47, 49, 59, 61, 63-68 and 72-77. Claims 23-28, 32-37, 48, 52-58 and 62 have been cancelled. Claims 21, 22, 30, 50, 51, 60 and 69-71 have been indicated to contain allowable subject matter.

The disclosed invention pertains to a transmission

tester for testing any type of vehicular transmission.

Representative claim 1 is reproduced as follows:

1. A transmission tester for testing vehicular transmissions, the transmission tester comprising:

(a) a main frame;

(b) a prime mover, for providing driving energy to a transmission to be tested;

(c) a headstock plate adapted to receive thereon a transmission to be tested, said headstock plate being supported from said main frame by a support, said support being mounted for povitation about a first axis, to thereby pivot said headstock plate about said first axis; and

(d) loading and braking apparatus, supported from said main frame, said loading and braking apparatus including a shaft journalled for rotation about a second axis substantially perpendicular to said first axis, and extending generally toward said headstock plate, for engaging an output shaft of the transmission to be tested, and for thereby applying braking energy to the transmission.

The examiner relies on the following references:

Weeder	4,732,036	Mar. 22, 1988
Sano et al. (Sano)	5,144,834	Sep. 08, 1992
Kuwahara	5,154,623	Oct. 13, 1992

The following rejections are on appeal before us:

1. Claims 1-10, 13-18, 38-44, 47, 63 and 72-77 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Weeder taken alone.

2. Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Weeder in view

of Kuwahara.

3. Claims 19, 20, 29, 31, 45, 46, 49, 59, 61 and 64-68 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Weeder in view of Kuwahara and further in view of Sano.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as

set forth in claims 1-20, 29, 31, 38-47, 49, 59, 61, 63-68 and 72-77. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the

examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-10, 13-18, 38-44, 47, 63 and 72-77 based on the teachings of Weeder taken alone. With respect to independent claims 1 and 38, the examiner acknowledges that Weeder does not teach the support for supporting the headstock plate from the main frame being pivotable about a first axis which is perpendicular to the

claimed second axis. Nevertheless, the examiner asserts that such an arrangement would have been obvious to the artisan [answer, pages 3-4]. With respect to independent claim 72, the examiner asserts that it would have been obvious to the artisan to modify the tester of Weeder so that it could test transmissions having longitudinally mounted transaxles as recited in claim 72 [id., page 5].

With respect to independent claim 1, appellant argues that the examiner has provided no legitimate reason or motivation for the artisan to modify the device of Weeder. Appellant argues that since Weeder did not intend to test longitudinally mounted transaxle transmissions, there would be no reason to provide a pivoting headstock plate as claimed [brief, pages 6-8].

We agree with the position argued by appellant. The examiner's proposed modification of Weeder is based on pure speculation and does not come from the teachings of the reference. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d

1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There is no suggestion within Weeder that the examiner's proposed modification should be made. Therefore, we do not sustain the examiner's rejection of independent claim 1 or of the claims which depend therefrom and are rejected on Weeder taken alone.

With respect to independent claim 38, appellant again argues that the examiner has admitted that Weeder does not teach the first and second axes as recited in claim 38. Appellant again argues that there is no motivation for the examiner's proposed modification of Weeder [brief, pages 9-11].

We again agree with appellant for the same reasons discussed above. Therefore, we do not sustain the rejection of independent claim 38 or of the claims which depend therefrom and are rejected on Weeder taken alone.

With respect to independent claim 72, appellant argues that the tester of Weeder does not have a support and a headstock plate having adjustable elements which enable adjustment of the headstock plate such that longitudinally

mounted transaxles can be tested [brief, pages 12-13].

We again agree with the position argued by appellant. The examiner's proposed modification of Weeder so that Weeder can work with longitudinally mounted transaxles does not come from Weeder. The only basis on this record to modify Weeder in the manner proposed by the examiner would be to improperly create appellant's invention in hindsight. Therefore, we do not sustain the rejection of independent claim 72 or of claims 73-77 which depend therefrom.

We now consider the rejection of claims 11 and 12 based on the teachings of Weeder and Kuwahara. These claims depend from claim 1 and additionally recite an eddy current device. Kuwahara was cited by the examiner only to meet the claim limitations related to the eddy current device. Kuwahara does not overcome the basic deficiencies of Weeder discussed above. Therefore, we do not sustain the examiner's rejection of claims 11 and 12.

We now consider the rejection of claims 19, 20, 29, 31, 45, 46, 49, 59, 61 and 64-68 based on the teachings of Weeder, Kuwahara and Sano. In addition to the teachings of Weeder and Kuwahara discussed above, the examiner cites Sano

as applying a range of resistance loads to simulate dynamic driving conditions. The examiner finds that it would have been obvious to the artisan to vary the resistance loads of Weeder by applying a range of such loads as taught by Sano [answer, pages 6-7].

With respect to independent claims 19 and 49, appellant argues that the claimed application of a plurality of resistance loads to the output element of the transmission being tested is not taught or suggested by any of the art of record. Specifically, appellant argues that dynamic driving conditions at the output element of the transmission cannot be simulated as claimed by the applied prior art [brief, pages 15-19].

We agree with appellant that a range of resistance loads to simulate dynamic driving conditions as recited in claims 19 and 49 is not taught or suggested by the applied prior art for the reasons set forth by appellant in the main brief. Therefore, we do not sustain the rejection of independent claims 19 and 49 or of the claims which depend therefrom.

In summary, we have not sustained any of the examiner's rejections of the appealed claims. Therefore, the decision of the examiner rejecting claims 1-20, 29, 31, 38-47, 49, 59, 61, 63-68 and 72-77 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

JOSEPH L. DIXON)
Administrative Patent Judge)

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